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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,216	05/04/2001	Susie J. Wee	10014739-1	9026

7590

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HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

DINH, MINH

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/849,216	Applicant(s) WEE ET AL.	
	Examiner Minh Dinh	Art Unit 2132	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed 10/24/2005. Claims 2-4, 6-10 and 12-16 have been amended; claims 1 and 5 have been cancelled.

2. It was stated in the response (page 7, Double Patenting) that a terminal disclaimer was being submitted; however, no such terminal disclaimer has been filed. Applicants are reminded to file a terminal disclaimer to obviate the double patenting rejection.

### ***Response to Arguments***

3. Applicant's arguments filed 10/24/05 with respect to the rejection of claim 10 under 35 USC § 101 for claiming non-functional descriptive material have been fully considered and are persuasive. The rejection of claim 10 under 35 USC § 101 for claiming nonfunctional descriptive material has been withdrawn. However, upon further consideration, a new ground of rejection under 35 USC § 101 for claim 10 is introduced in this Office action. The delay in citation of the new rejection is regretted.

4. Applicant's arguments filed 10/24/05 with respect to the rejections of claims 4 and 14 under 35 USC § 101 for claiming nonfunctional descriptive material have been fully considered but they are not persuasive. Regarding claim 4, the amended claim language still does not describe a functional interrelationship between a piece of data,

i.e., the information in the header portion of the packet, and the transcoder in the claim context. Regarding claim 14, the truncation point in the data portion of the packet does not, in and of itself, causes any functionality to take place. The specification discloses that the transcoder reads the header portion, rather than the data portion, in order to identify the truncation points (page 22, lines 17-31).

5. Applicant's arguments filed 10/24/05 with respect to the rejection of claim 10 under 35 USC § 112, second paragraph, as being incomplete for omitting essential elements have been fully considered and are persuasive. The rejection of claim 10 under 35 USC § 112, second paragraph, as being incomplete for omitting essential elements has been withdrawn.

6. Applicant's arguments filed 10/24/05 with respect to the rejections of claims 4 and 14 under 35 USC § 112, second paragraph, as being incomplete for omitting essential elements have been fully considered but they are not persuasive. Regarding claim 4, the amended claim language still does not describe a functional interrelationship between a piece of data, i.e., the information in the header portion of the packet, and the transcoder in the claim context. Regarding claim 14, the truncation point in the data portion of the packet does not, in and of itself, causes any functionality to take place. The specification discloses that the transcoder reads the header portion, rather than the data portion, in order to identify the truncation points

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(page 22, lines 17-31). As a result, claims 4 and 14 omit essential elements that cause a functional change in the operation of the transcoder as stated in the preamble.

7. Upon further consideration, a new ground of rejection under 35 USC § 101 for claims 4 and 14 is introduced in this Office action. The delay in citation of the new rejections is regretted.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 2-4, 6-10 and 12-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12

of copending Application No. 10/245172 in view of Bachtiar et al ("A Secure Video On Demand System").

This is a provisional obviousness-type double patenting rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application is obvious in view of the copending application. The copending application discloses the same limitations as the present application with two exceptions: (a) the data portion being progressively encrypted; and (b) the header enabling the transcoder to transcode the encrypted data portion without decrypting/re-encrypting the data portion. Bachtiar discloses video data portion being progressively encrypted (Abstract; fig. 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the encryption technique, as taught by Bachtiar, so as to prevent unauthorized access to the data.

Since the transcoder in the copending application can transcode the data portion without decoding/re-encoding the data portion, there is no need for the transcoder to decrypt/re-encrypt the data portion. Therefore, the limitation "the header enabling the transcoder to transcode the encrypted data portion without decrypting/re-encrypting the data portion" is obvious in view of the above combination

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 2-4, 6-9 and 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a data packet stored in a computer readable medium, the data packet comprising a data portion and a header data portion including information used by a transcoder.

Regarding claim 4, the claim language does not describe a functional interrelationship between a piece of data, i.e., the information in the header portion of the packet, and the transcoder in the claim context. Regarding claim 14, the truncation point in the data portion of the packet does not, in and of itself, causes any functionality to take place.

The specification discloses that the transcoder reads the header portion, rather than the data portion, in order to identify the truncation points (page 22, lines 17-31). Therefore, the data packets of claims 4 and 14 are non-functional descriptive material and the claims are nonstatutory. Claims that are not specifically addressed are rejected by virtue of their dependency

12. Claims 2-4 and 6-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a scalably encoded data packet stored in a computer readable medium. However, the specification discloses that the scalably encoded data packet is utilized in intangible embodiments (e.g., transmission medium such as a communications network).

Specifically, the specification discloses that the scalably encoded data packet is transmitted to an intermediate device, i.e., a transcoder, using a transmission medium such as a wireless network or a hybrid wired/wireless network (Background Art; figures

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15A-B and corresponding text). Since claims 2-4 and 6-16 recite just transmitted signal encoded with either non-functional descriptive material (claims 4 and 14) or functional descriptive material (claim 10), the claims are nonstatutory.

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 14-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 14, the amended feature includes "said transcoder reading said data portion to identify said truncation point and truncating said data portion at said truncation point" (lines 7-9). However, the specification discloses that the transcoder reads the header portion, rather than the data portion, in order to identify the truncation point(s) and uses the identified truncation point(s) to truncate the data portion (page 22, lines 17-31). The amended feature was not disclosed in the specification as originally filed and, therefore, is considered new matter. Claims that are not specifically addressed are rejected by virtue of their dependency.



15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 2-4, 6-9 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Regarding claim 4, the amended claim language does not describe a functional interrelationship between a piece of data, i.e., the information in the header portion of the packet, and the transcoder in the claim context. Regarding claim 14, the truncation point in the data portion of the packet does not, in and of itself, causes any functionality to take place. The specification discloses that the transcoder reads the header portion, rather than the data portion, in order to identify the truncation points (page 22, lines 17-31). As a result, claims 4 and 14 omit essential elements that cause a functional change in the operation of the transcoder as stated in the preamble. Claims that are not specifically addressed are rejected by virtue of their dependency.

***Allowable Subject Matter***

17. Claims 10-13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action. An appropriate terminal disclaimer to overcome the double patenting rejection is also to be filed.

18. Claims 2-4, 6-9 and 14-16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. An appropriate terminal disclaimer to overcome the double patenting rejection is also to be filed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

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